1652

PATENT APPLICATION
ATTORNEY DOCKET NO.: 01017/36524A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Boylan *et al.*

Serial No: 09/909,474

Filed: July 19, 2001

For: Novel Serine Threonine Kinase Member, h2520-59

Group Art Unit: 1652

Examiner: Maryam Monshipouri

I hereby certify that this paper and the petition and fee referred to as being filed herewith are being deposited with the United States Postal Service with sufficient postage as first class mail, postage prepaid, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450:

Date: November 7, 2003

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ELECTION WITH TRAVERSE IN RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir/Madam:

This is in response to a restriction requirement dated October 7, 2003, wherein the examiner asserted that pending claims 1-76 were directed to eleven distinct inventions and required restriction. Reconsideration is requested. This response is timely filed.

REMARKS

I. Restriction

Citing 35 U.S.C. § 121, the examiner asserted that claims 1-76 were drawn to eleven distinct inventions:

Group I:	Claims 1-8, 10-11, 53-55, 68-69, and 75-76, drawn to isolated DNA molecules encoding a human serine/threonine kinase (h2520-59), vectors and host cells comprising said molecules, methods of expressing said molecules, and compositions comprising said molecules;
Group II:	Claims 9, 14-24, 47-52, and 56-57, drawn to said kinase, compositions comprising said kinase, and fusion products of said kinase;
Group III:	Claims 25-40, and 45-46, drawn to antibodies which specifically bind said kinase and methods of using said antibodies;
Group IV:	Claims 30, and 41-43, drawn to modulators of said polypeptides;
Group V:	Claims 12-13, 44, 58-60, and 65, drawn to methods of using said modulators;
Group VI:	Claim 61, drawn to methods of treatment using said kinase;
Group VII:	Claim 62, drawn to methods of diagnosing a disease caused by said kinase using said DNA molecules;
Group VIII:	Claims 63-64, drawn to devices comprising encapsulated cells comprising said kinase;
Group IX:	Claim 66, drawn to methods of modulating said kinase;
Group X:	Claim 67, drawn to transgenic non-human animals comprising said DNA molecules; and
Group XI:	Claims 70-73, drawn to hybridization assays using said DNA molecules.

II. Election

The applicants hereby elect Group I, which includes claims 1-8, 10-11, 53-55, 68-69, and 75-76, drawn to isolated DNA molecules encoding a human serine/threonine kinase

(h2520-59), vectors and host cells comprising said molecules, methods of expressing said molecules, and compositions comprising said molecules, with traverse.

III. Argument

The examiner has restricted the pending claims into eleven groups. The examiner asserted that the applicants are claiming eleven distinct inventions. In response, the applicants respectfully traverse.

The applicants request that the restriction requirement be reconsidered because the examiner has not shown that a serious burden would be required to examine the claims of Groups I-XI. M.P.E.P. § 803 provides:

> If the search and examination of an application can be made without serious burden, the Examiner **must** examine it on the merits, even though it includes claims to distinct or independent inventions. (*Emphasis added.)*

Thus, for a restriction to be proper, the examiner must satisfy the following two criteria: (1) that independent and distinct inventions are being claimed (35 U.S.C. § 121); and (2) that the search and examination of the entire application cannot be made without serious burden. *See* M.P.E.P. § 803.

The applicants submit that the examiner has not established that a serious burden would be imposed on the Patent Office if all 76 claims under consideration were searched and examined together. The polypeptide sequence of Group II is encoded by the polynucleotide sequence of Group I. It is probable that a search based on the polypeptide sequences of Group II will involve the same prior art and identify similar art compared to a search based on the polynucleotide of Group I. Moreover, existing search engines permit a searcher to search translations of known polynucleotide sequences in all reading frames automatically, permitting rapid comparisons of polynucleotide and polypeptide databases. The applicants also submit that it would not pose a serious burden on the examiner to also examine 1) Group VII, using DNA of Group I for diagnosis; 2) Group X, using DNA of Group I in a transgenic animal; and 3) Group XI, using the DNA of Group I for hybridization assays, because patentability of the DNA of Group I will establish novelty for these groups as well. Moreover, the applicants would like to formally request rejoinder of Groups VII, X, and XI under M.P.E.P. § 821.04 if the claims of Group I are found patentable. Thus, it would

not be a serious burden on the Examiner to do one search based on the claims in Groups I and II, VII, X, and XI.

In light of the above comments and in view of the subject matters of the claims under consideration, the applicants submit that the examiner has failed to establish that a serious burden would be imposed if all of these claims were searched and examined in the instant application. Accordingly, the applicants submit that the restriction requirement has been overcome and should be withdrawn.

CONCLUSION

For the foregoing reasons, applicants request reconsideration and withdrawal of the restriction requirement. Should the examiner have any questions or comments regarding this response or the application, the examiner is invited to contact the undersigned at the number indicated.

Respectfully submitted,

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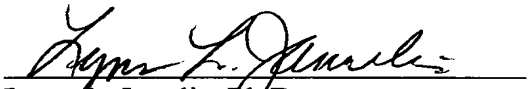
By 

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November 7, 2003